

MAR 28 2008

~~21229-211A-3789~~ PCT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HIDEYOSHI HORIMAI

Serial No.: 10/556,651

Filed: November 11, 2005

For: OPTICAL INFORMATION  
RECORDING/REPRODUCING  
DEVICE AND METHOD

Art Unit: --

Examiner: --

**RESPONSE TO  
NOTIFICATION OF MISSING REQUIREMENT UNDER 35 U.S.C. 371 IN THE  
UNITED STATES DESIGNATED/ELECTED OFFICE**Mail Stop: Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is to respond to the "Notification of Missing Requirement Under 35 U.S.C. 371 in the United States Designated/Elected Office" (copy attached) dated February 1, 2008, noting --The following item MUST be furnished ...: Processing fee of \$130 for providing translation of the application--, and further noting --Total additional fees required to this application is \$130 for a Small Entity: \$130 for English translation surcharge required.--

From the descriptions in the Notification, it is the undersigned understanding that U.S. Patent Office takes the position that the present U.S. National Stage application under 35 U.S.C. was filed in the U.S. Patent Office without an English translation, and since \$130 surcharge for English translation has not been paid, the applicant needs to pay the \$130 to the Patent Office to avoid abandonment.

However, the undersigned respectfully submits that an English translation of the PCT application was duly filed when the present U.S. National Stage application was filed on November 11, 2005. In other words, the present National Stage application was filed with an

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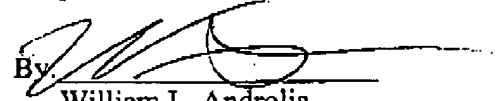
English translation of the PCT application. This is clear from the marking to the box 6 for "An English language translation of the International Application as filed" listed in the filed Transmittal Letter to the United States Designated/Elected Office Transmittal Letter to the United States Designated/Elected Office Concerning a Filing Under 35 U.S.C. 371. A copy of this letter is attached. Further attached is a copy of the returned Postcard that lists "44 pages of the specification" that meant an English translation of the PCT specification.

In view of the above, therefore, since the present application was filed with an English translation of the PCT specification, and an English translation was thus not required to be filed after the application was filed, and further the undersigned did not file an English translation after the application was filed, there is no surcharge for submitting an English translation is required in the present application. The undersigned believes that the Notification was issued by an error, and it is respectfully requested that the Patent Office withdraw the Notification.

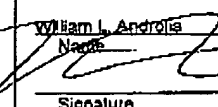
If, however, a further search in the Patent Office finds anything lack for the present application, it is respectfully request that the Patent Office call the undersigned on that matter.

The Commissioner is further authorized to charge any underpayment to our Deposit Account No. 50-4367.

Respectfully submitted,

By   
William L. Androlia  
Reg. No. 27,177

Quinn Emanuel Urquhart Oliver & Hedges LLP  
Koda/Androlia  
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Certificate of Transmission	
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571)273-8300	
on	March 28, 2008
Date of Deposit	
Signature	
	3/28/2008
	Date

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

U.S. APPLICATION NUMBER NO. 10/556,651	FIRST NAMED APPLICANT Hideyoshi Horimai	ATTY. DOCKET NO. 211A 3789 PCT
INTERNATIONAL APPLICATION NO. PCT/JP04/06464		
I.A. FILING DATE 05/13/2004	PRIORITY DATE 05/13/2003	

3713

QUINN EMANUEL

KODA &amp; ANDROLIA

865 S. FIGUEROA STREET, 10TH FLOOR  
LOS ANGELES, CA 90017THIS MATTER DOCKETED  
FOR 4/1/08

QUINN EMANUEL

CONFIRMATION NO. 6539  
371 FORMALITIES LETTER

CC00000028011979

Date Mailed: 02/01/2008

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- Indication of Small Entity Status
- Priority Document
- Copy of the International Application filed on 11/12/2005
- English Translation of the IA filed on 01/27/2006
- Copy of the International Search Report filed on 11/12/2005
- Copy of IPE Report filed on 01/27/2006
- Oath or Declaration filed on 01/27/2006
- U.S. Basic National Fees filed on 01/27/2006
- Assignment filed on 01/27/2006
- Priority Documents filed on 01/27/2006

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Processing fee of \$130 for providing a translation of the application and/or the Annexes later than 30 months from the priority date (37 CFR 1.492(i)).

#### SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Small Entity:

- \$130 for English translation surcharge required.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.

<https://portal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

page 1 of 2

FORM PCT/DO/EO/905 (371 Formalities Notice)

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

**If you are not using EFS-Web to submit your reply, you must include a copy of this notice.**

CHARITTA A SHELTON

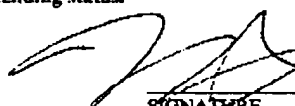
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Telephone: (703) 308-9140 EXT 207

Express Mail EV714371907US

FORM PTO-1390 (REV. 10-2003)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTORNEY'S DOCKET NUMBER <b>211A 3789 PCT</b>
<b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371</b>			U.S. APPLICATION NUMBER (if known, see 37 C.F.R. 1.5) —
INTERNATIONAL APPLICATION NO. <b>PCT/JP2004/006464</b>	INTERNATIONAL FILING DATE <b>May 13, 2004</b>	PRIORITY DATE CLAIMED <b>May 13, 2003</b>	
TITLE OF INVENTION <b>OPTICAL INFORMATION RECORDING/REPRODUCTION DEVICE AND METHOD</b>			
APPLICANT(S) FOR DO/EO/US <b>HIDEYOSHI HORIMAI</b>			
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:			
1. <input checked="" type="checkbox"/> This is a <b>FIRST</b> submission of items concerning a filing under 35 U.S.C. 371. 2. <input type="checkbox"/> This is a <b>SECOND</b> or <b>SUBSEQUENT</b> submission of items concerning a filing under 35 U.S.C. 371. 3. <input checked="" type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (20) indicated below. 4. <input type="checkbox"/> The US has been elected (Article 31). 5. <input checked="" type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2)) a. <input type="checkbox"/> is attached hereto (required only if not transmitted by the International Bureau). b. <input checked="" type="checkbox"/> has been communicated by the International Bureau. c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US). 6. <input checked="" type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)). a. <input checked="" type="checkbox"/> is attached hereto b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4). 7. <input checked="" type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)) a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau). b. <input type="checkbox"/> have been communicated by the International Bureau. c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired. d. <input checked="" type="checkbox"/> have not been made and will not be made. 8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)). 9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). 10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).  Items 11 to 19 below concern document(s) or information included: 11. <input type="checkbox"/> An Information Disclosure Statement under 37 C.F.R. 1.97 and 1.98. 12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 C.F.R. 3.28 and 3.31 is included. 13. <input type="checkbox"/> A preliminary amendment. 14. <input checked="" type="checkbox"/> An Application Data Sheet under 37 CFR 1.76. 15. <input type="checkbox"/> A substitute specification. 16. <input type="checkbox"/> A power of attorney and/or change of address letter. 17. <input type="checkbox"/> A second copy of the published international application under 35 U.S.C. 154(d)(4). 18. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4). 19. <input checked="" type="checkbox"/> Other items or information: a. Copy of Form PCT/IB/308 (First Notice of Informing Application of Communication of International Application) b. Copy of Form PCT/IB/308 (Second Notice of Informing Application of Communication of International Application) c. Copy of Form PCT/ISA/210 (International Search Report) d. Seventeen (17) sheets of drawings			

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U.S. APPLICATION NO. (if known, see 37 C.F.R. 1.5)		INTERNATIONAL APPLICATION NUMBER PCT/JP2004/006464		ATTORNEY'S BOOKET NUMBER 211A 3789 PCT	
20. <input checked="" type="checkbox"/> The following fees are submitted:					
<b>BASIC NATIONAL FEE (37 C.F.R. 1.492(a)(1)-(5)):</b>					
Neither international preliminary examination fee (37 C.F.R. 1.482) nor international search fee (37 C.F.R. 1.445(a)(2)) paid to USPTO and International Search Report not prepared by the EPO of JPO ..... \$1,000					
International preliminary examination fee (37 C.F.R. 1.482) not paid to USPTO but International Search Report prepared by the EPO or JPO ..... \$1,000					
International preliminary examination fee (37 C.F.R. 1.482) not paid to USPTO but international search fee (37 C.F.R. 1.445(a)(2)) paid to USPTO ..... \$770					
International preliminary examination fee (37 C.F.R. 1.482) paid to USPTO but all claims did not satisfy provisions of PCT Article 33(1)-(4) ..... \$200					
International preliminary examination fee (37 C.F.R. 1.482) paid to USPTO and all claims satisfied provisions of PCT Article 33(1)-(4) ..... \$100					
ENTER APPROPRIATE BASIC FEE AMOUNT =					\$ 1,000
Surcharge of \$130 for furnishing the oath or declaration later than months from the earliest claimed priority date (37 C.F.R. 1.492(c)). <input type="checkbox"/> 20 <input type="checkbox"/> 30					\$ 0
CLAIMS	NUMBER FILED	NUMBER ALLOWED	NUMBER EXTRA	RATE	
Total claims	66	20	46	\$ 50	\$2,300
Independent claims	14	3	11	\$ 200	\$2,200
MULTIPLE DEPENDENT CLAIM(S) (if applicable)				+	\$360
TOTAL OF ABOVE CALCULATIONS =					\$5860
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2.					\$2930
SUBTOTAL =					\$2,930
Processing fee of \$130 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 C.F.R. 1.492(f)). <input type="checkbox"/> 20 <input type="checkbox"/> 30					\$ 0
TOTAL NATIONAL FEE =					\$2,930
Fee for recording the enclosed assignment (37 C.F.R. 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 C.F.R. 3.28, 3.31). \$40 per property					\$ 0
TOTAL FEES ENCLOSED =					\$2,930
\$					
a. <input checked="" type="checkbox"/> Checks in the amounts of \$ and \$2,930 to cover the above fees are enclosed.					
b. <input type="checkbox"/> Please charge my Deposit Account No. 11-1445 in the amount of _____ to cover the above fees. A duplicate copy of this sheet is enclosed.					
c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-1445. A duplicate copy of this sheet is enclosed.					
NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.					
SEND ALL CORRESPONDENCE TO:					
KODA & ANDROLIA					
2029 Century Park East, Suite 1140					
Los Angeles, CA 90067-2983					
Dated: November 11, 2005					
Form PTO-1390 (REV 10-2003)					
 SIGNATURE William L. Androlia REG. NO. 27,177					

Express Mail EV714371907US

211A 3789 PCT NAKAO &amp; ITO

Inventor(s): Hideyoshi Horimai

For: OPTICAL INFORMATION

RECORDING/REPRODUCTION DEVICE AND METHOD

New PCT application transmittal form; mailing certification; application data sheet; 44 pages of the specification; 17 sheets of drawings; copy of Form PCT/IB/308 (first notice re application to the designated offices); copy of form PCT/IB/308 (second notice re application to the designated offices); copy of form PCT/ISA/210 (international search report); and a check for \$2,930.00

Sent to PTO 11/11/05

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10/556651

DEC - 2 2005

KODA &amp; ANDROLIA RECEIVED PCT/PTO 12 NOV 2005